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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/265,307	03/09/1999	NIGEL L. WEBB	N0260/7031(E)	4390

7590 03/14/2002

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600 ATLANTIC AVENUE  
BOSTON, MA 02210

EXAMINER

TRINH, BA K

ART UNIT	PAPER NUMBER
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1625

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DATE MAILED: 03/14/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/265,307

Applicant(s)

WEBB et al

Examiner

TRINH

Group Art Unit

1625

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☒ Responsive to communication(s) filed on 10-22-01.
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 1, 5, 7-10, 12, 15, 17, 21, 23-26, 28, 31, 33, 37, 39-42, 46, 57, 62, 65, 69-70, 75, 78, 82, 84,  
89-90, 94, 97, 101, 103, 107-108, 110, 114
- ☒ Claim(s) 1, 5, 7-10, 12, 15, 17, 21, 23-26, 28, 31, 33, 37, 39-42, 46, 57, 62, 65, 69-70, 75, 78, 82, 84, 89-90, 94, 97, 101, 103, 107-108, 110, 114 is/are pending in the application.
  - ☐ Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
  - ☐ Claim(s) \_\_\_\_\_ is/are allowed.
  - ☒ Claim(s) above is/are rejected.
  - ☐ Claim(s) \_\_\_\_\_ is/are objected to.
  - ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☒ The drawing(s) filed on 3-9-99 is/are objected to by the Examiner. (Paper No. 4)
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
  - ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
  - ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
  - ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other \_\_\_\_\_

Office Action Summary

Claims 1, 5, 7-10, 12, 15, 17, 21, 23-26, 28, 31, 33, 37, 39-42, 46, 57, 62, 65, 69-70, 75, 78, 82, 84, 89-90, 94, 97, 101, 103, 107-108, 110 and 114 are pending.

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/22/2001 has been entered.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 5, 7-10, 12, 15, 17, 21, 23-26, 28, 31, 33, 37, 39-42, 46, 57, 62, 65, 69-70, 75, 78, 82, 84, 89-90, 94, 97, 101, 103, 107-108, 110 and 114 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6 of U.S. Patent No. 5,919,815 (Bradley et al.). Although the conflicting claims are not identical, they are not patentably distinct from each other

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because the instant taxane embraces the taxol species and the instant fatty acid embraces the docosahexaenoic acid as a species.

Applicant's remarks filed on 10/22/2001 had been considered, but not found persuasive. The instant invention and the patented invention bear the relationship of genus versus species.

A wide range of dosage is taught by Bradley et al to treat cancer; note lines 10-21 column 18 of the patent. Thus, the claimed invention would be deemed obvious over the patented invention.

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ba Trinh whose telephone number is 308-4545. The examiner can normally be reached on Monday to Thursday from 8:30 AM to 5 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alan Rotman, can be reached on (703) 308-4698. The fax phone number for the organization where this application or proceeding is assigned is 308-7922.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 308-1235.

Trinh/LR

February 26, 2002



BA K. TRINH  
PRIMARY EXAMINER  
GROUP 1200/625